

### REMARKS

By this Amendment, claims 2 and 3 are amended and claims 19 and 20 are newly added. Claims 4, 5, 7, 8 and 18 have been withdrawn from consideration. Support for the amendments to claims 2 and 3 may be found for example on pages 16-19 of the specification and in FIGS. 8 and 9. Support for new claims 19 and 20 may be found, for example, on pages 3 and 16-19 of the specification and in FIG. 8. No new matter has been added. After entry of the Amendment, claims 1-20 will remain pending in the present application. Reconsideration and allowance of the present patent application in view of the above amendments and the following remarks are respectfully requested.

Before addressing the Examiner's rejection, Applicant would like to express appreciation for the Examiner's indication that claim 1 is allowed.

#### **I. Claim Rejections – 35 U.S.C. §102**

Claims 2, 3, 6/2, 6/3, 9/2, 10/9/2, 11/2, 12/2, 16/2, and 17 were rejected under 35 U.S.C. § 102(b) based on Novis (U.S. Patent No. 5,867,795). The rejection is respectfully traversed.

Claim 2, as amended, recites a viewing optical system comprising, *inter alia*, a prism and a reflecting element having a reflecting surface, said prism being a separate optical element from said reflecting element, wherein said prism is received in a body of said portable image display, and said reflecting element is held by a frame member, which is independent of said body. Therefore, claim 2 positively recites two separate optical elements, a prism and a reflecting element, that are received in two separate units, a frame and a body. Novis does not describe a device including at least this feature. Therefore, Novis does not describe each and every feature recited by claim 2 and, as a result, cannot anticipate this claim.

Novis discloses a portable electronic device 10 including a portable housing 11, which is composed of a base component 12 and an attached flipper component 13. (See FIG. 1 and col. 3, lines 25-34) Novis also discloses that housing 11 has a visual display 20 mounted therein for providing a visual image. (See col. 3, lines 46-47) Novis further discloses that the visual display includes a prism portion, an optical lens and a lower power lens. (See FIG. 11 and col. 8, line 31 – col. 9, line 64) Novis is silent, however, about a reflecting element having a reflecting surface, which is a separate optical element from the prism.

Claims 6/2, 9/2, 10/9/2, 11/2, 12/2, 16/2 and 17 are patentable by virtue of their dependency from claim 2 and for the additional features recited therein. In particular, it is noted that, contrary to what is stated in the Office Action, Novis fails to teach or suggest a prism

having at least one reflecting surface that has a curved surface shape for imparting power to a light beam, said curved surface shape being defined by a rotationally asymmetric surface shape capable of making correction for decentration aberrations, as recited in claim 6.

Claim 3, as amended, recites a portable image display comprising, *inter alia*, an image display device, an image pickup device and an image pickup optical system, wherein the image pickup device is adapted to generate an electrical signal corresponding to said image formed thereon by said image pickup optical system. Novis does not describe a device including at least these features. Therefore, Novis does not describe each and every feature recited by claim 3 and, as a result, cannot anticipate this claim.

Claim 6/3 is patentable by virtue of its dependency from claim 3 and for the additional features recited therein.

Accordingly, reconsideration and withdrawal of the rejection of claims 2, 3, 6/2, 6/3, 9/2, 10/9/2, 11/2, 12/2, 16/2, and 17 based on Novis are respectfully requested.

## **II. New Claims**

Claims 19 and 20 are newly added. Claim 19 corresponds to claim 6 written in independent form. As mentioned previously, Novis is silent about a prism having at least one reflecting surface that has a curved surface shape for imparting power to a light beam, said curved surface shape being defined by a rotationally asymmetric surface shape capable of making correction for decentration aberrations. Therefore, it is respectfully submitted that claim 19 is patentable over Novis. Claim 20 is patentable over Novis by virtue of its dependency from claim 2 and for the additional features recited therein. Accordingly, it is respectfully submitted that new claims 19 and 20 are in condition for allowance.

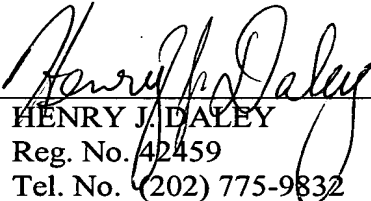
### III. Conclusion

The rejection having been addressed, Applicant requests issuance of a notice of allowance indicating the allowability of all pending claims. If anything further is necessary to place the application in condition for allowance, Applicant requests that the Examiner contact Applicant's undersigned representative at the telephone number listed below.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

PILLSBURY WINTHROP LLP

By:   
HENRY J. DALEY  
Reg. No. 42459  
Tel. No. (202) 775-9832  
Fax No. 703 905-2500

HJD/RCP/CFL  
Date: May 24, 2004  
P.O. Box 10500  
McLean, VA 22102  
(703) 905-2000